

REMARKS

This application pertains to a novel flexible polyamide-containing film. The novel film has outstanding optical properties, a high degree of stiffness and good surface slip (page 8, lines 1-8; page 13, lines 30-32).

Claims 1-9 are pending, although claims 7-9 have been withdrawn from consideration as drawn to a non-elected invention.

It is respectfully requested that upon the allowance of elected subject matter the non-elected claims be rejoined (MPEP 821.04).

Claims 1, 3, 4 and 6 stand rejected under 35 USC 102(b) as anticipated by Maxfield et al (US 5,385,776).

The polyamide layer (I) of Applicants' film contains solid, anisotropic, nucleating fillers (A), in the limited amount of from 0.01 to 1 wt.%, and comprises substantially spherulitically crystallized polyamide, the spherulites of which contain, as their nuclei, the solid, anisotropic, nucleating fillers (A), and wherein the individual spherulites (in at last one plane perpendicular to the surface of the film) exhibit a diameter of not greater than 1,000 nm nor less 100 nm.

It should be especially noted that Applicants spherulites have, on numerical

averag ,  $100 \text{ nm} \leq \text{dlameter} \leq 1,000 \text{ nm}$ . This special range of diameters of the polyamide spherulites are obtained by special processing, as disclosed in the specification, and, in combination with the limited amount of filler (A), results in a combination of advantageous properties of the film product, such as low after-shrinkage, high gloss, low haze, good producibility (flatness), low coefficient of sliding friction and high modulus of elasticity (as demonstrated by the test results shown on page 23 of the specification).

Maxfield, by contrast, does not teach or suggest anything at all about a film which comprises spherulitically crystallized polyamide having spherulite dlameters which are no greater than 1000 nm and no smaller than 100 nm, and having anisotropic fillers as their nuclei.

The Examiner, in the office action, argued that Applicants' claims did not recite the size and amounts of crystallites. Actually, the original claims did recite the size, and have now been amended to recite the amount. Support for the amendment to claim 1 may be found at page 8, lines 22-23.

Claim 1 has also been amended to recite "comprised of" instead of "consisting of—". It is clear from the disclosure that layer (I) is open to additional components, from the language at page 8, lines 29-30, and that therefore "consisting of" does not correctly describe Applicants' films.

With regard to the size of the spherulites in Applicants' film, it should be noted that the claimed size range is obtained by Applicants through the use of special processing conditions during the film-forming process (page 12, line 13 through page 13, line 5).

Maxfield does not teach or suggest anything at all about this special range of spherulite size, nor any film process conditions by which they might be achieved in a polyamide film.

In this regard it is respectfully pointed out that if the Examiner relies on a theory of inherency with respect to Applicants' combination of a film having the specified limited amount of filler (A), with polyamide spherulites having anisotropic filler as crystal nuclei and the specified size range of the spherulites, then extrinsic evidence must make clear that such combination of elements is *necessarily* present in the composites described in Maxfield, and that the presence of such combination of elements therein would be so recognized by persons skilled in the art. *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Further, inherency is not established by probabilities or possibilities, and the mere fact that a property *may* result from a given circumstances is not sufficient; instead it must be shown that such property *necessarily* inheres in the thing described in the reference. *Id.* There is no specific teaching or even suggestion in Maxfield of the foregoing combination of elements, and Maxfield therefore cannot anticipate the present claims.

Accordingly, the rejection of claims 1, 3, 4 and 6 under 35 USC 102(b) as

anticipated by Maxfield should now be withdrawn.

Claims 1-6 stand rejected under 35 USC 103(a) as obvious over Goehring et al (US 3,791,915) in view of Maxfield (US 5,385,776).

The Examiner acknowledges that Goehring does not teach that the polyamide should comprise the claimed composition.

As discussed above, Maxfield also does not teach or suggest Applicants novel polyamide film (I). Therefore, no combination of Geohring and Maxfield could ever lead to Applicants' novel film.

The rejection of claims 1-6 under 35 USC 103(a) as obvious over Goehring in view of Maxfield should accordingly now be withdrawn.

In view of the present amendments and remarks it is believed that claims 1-9 are now in condition for allowance. Reconsideration of said claims by the Examiner is respectfully requested and the allowance thereof is courteously solicited. Should the Examiner not deem the present amendment and remarks to place the instant claims in condition for allowance, it is respectfully requested that this Amendment Under Rule 116 be entered for the purpose of placing the prosecution record in better condition for appeal.

CONDITIONAL PETITION FOR EXTENSION OF TIME


If any extension of time for this response is required, applicant requests that this be considered a petition therefor. Please charge the required Petition fee to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess to our Deposit Account No. 14-1263.

Respectfully submitted

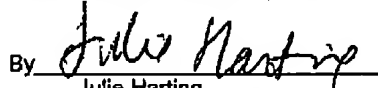
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I hereby certify that this correspondence is being transmitted via facsimile, no. 703-872-9306 to the United States Patent and Trademark Office, addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on October 9, 2003.

By   
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